

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

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Washington, D.C. 20231

SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/563,417	2/22/06	VOLKER BACHMANN, ET AL.	ZAHFRI P803US

Title: **METHOD FOR CONTROLLING AND REGULATING A  
TRANSMISSION BRAKE IN AN AUTOMATIC MOTOR  
VEHICLE TRANSMISSION**

Art Unit	Paper Number
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Correspondence Address:

MICHAEL J. BUJOLD

500 N. COMMERCIAL ST., 4TH FL.

MANCHESTER, NH 03101

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 540,092

Grant Date: 21-Mar-08

**This license is granted retroactively to  
the date(s) and the country(s) indicated  
on the attached decision.**

Approved:

  
for Commissioner of Patents and Trademark

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license does not empower the filing of any applications, amendments, supplements or continuances originating in this country which disclose inventions, modifications, or variations not disclosed in the subject matter identified above.

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lesson the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Office of Foreign Assets Control, Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

**LICENSE FOR FOREIGN FILING**

[Title 35, United States Code (1952) Sections 184, 185, 186]



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

Davis & Bujold, P.L.L.C.  
112 Pleasant Street  
Concord, NH 03301-2931

In re: Volker Bachmann, et al : DECISION ON REQUEST  
Serial No.: 10/563,417 : UNDER 37 CFR 5.25  
Filing date: 22 February 2006  
Docket No: ZAHFRI P803U

Title: METHOD FOR CONTROLLING AND REGULATING A TRANSMISSION BRAKE  
IN AN AUTOMATIC MOTOR VEHICLE TRANSMISSION

In view of the communication(s) filed 18 January 2007 2007, it has been determined that a retroactive license for foreign filing under 35 U.S.C. 184 be granted with respect to the filings listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under secrecy order, that the license was diligently sought after discovery of the proscribed foreign filing, and that the material was filed abroad without the required license under 37 C.F.R. 5.11 first having been obtained through error and without deceptive intent.

Country

Date

Germany  
PCT

5 July 2003  
8 June 2004

Approved:

Andrea M. Valenti  
Primary Examiner  
Group 3643  
(571)272-6895

13 March 2008

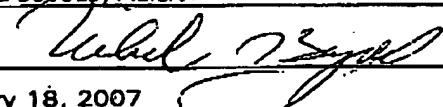
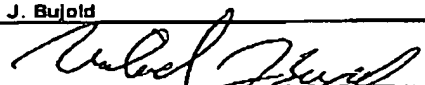
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JAN 18 2007

PTO/SB/21 (12-97)

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	10/563,417
	Filing Date	with an effective filing date of June 8, 2004
	First Named Inventor	Volker BACHMANN, Mario STEINBORN, Rudolf KALTHOFF and Anthony Robert SAYMAN
	Group Art Unit	3681
	Examiner Name	Fax: (871) 273-8300
Total No. of Pages in this Submission: 5	Attorney Docket Number	ZAHFRI P803US
ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee attached <input checked="" type="checkbox"/> Amendment/Response - 2 pgs. <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request (in Duplicate) <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Part/s Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition (DELETED - no longer useful) <input type="checkbox"/> To Convert a Provisional Petition <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request for Refund	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below): Declaration - 2 pgs.
REMARKS		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual Name	Michael J. Bujold DAVIS & BUJOLD, P.L.L.C.	
Signature		
Date	January 18, 2007	
CERTIFICATE OF TRANSMISSION		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO on January 18, 2007		
Type or printed name	Michael J. Bujold	
Signature		
		Date: January 18, 2007 (1)

**RECEIVED  
CENTRAL FAX CENTER****BEST AVAILABLE COPY****JAN 18 2007****PATENT APPLICATION****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Volker BACHMANN, Mario STEINBORN,  
Rudolf KALTHOFF and Anthony Robert  
SAYMAN  
Serial no. : 10/563,417  
Filed : with an effective filing date of June 8, 2004  
For : METHOD FOR CONTROLLING AND  
REGULATING A TRANSMISSION BRAKE IN  
AN AUTOMATIC MOTOR VEHICLE  
TRANSMISSION  
Group Art Unit : 3643  
Examiner : Andrea M. Valenti  
Docket : ZAHFRI P803US

The Commissioner for Patents  
U.S. Patent & Trademark Office  
P. O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE**

In response to the Decision on Request under 37 CFR 5.25, mailed December 5, 2006, in which the Petition for a Retroactive Foreign Filing License was denied for the reasons set forth in that Decision, the Applicant hereby requests reconsideration of the previously filed Petition for a Retroactive Foreign Filing License in view of the attached new Declaration.

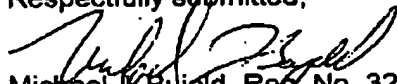
As indicated in the Decision, the Petition was denied by the Examiner because there was no "showing that the foreign filing license was diligently sought after the discovery of the proscribed foreign filing." Upon reviewing the previously filed Declaration, a typographical error was noted in that Declaration. That is, the filing date of the Application in the United States actually occurred on January 4, 2006, instead of January 4, 2005, as misstated in the previous Declaration. Thus, the time between the filing date of January 4, 2006 and the filing date of the Petition for a Retroactive Foreign Filing License, February 6, 2006 was just over one (1) month and not over one (1) year as was suggested by the prior Declaration. The enclosed newly signed Declaration corrects this error and the Applicant hereby requests reconsideration of the previously filed Petition for a Retroactive Foreign Filing License at this time.

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10/563,417

In the event that there are any fee deficiencies or additional fees are payable,  
please charge the same or credit any overpayment to our Deposit Account (Account  
No. 04-0213).

Respectfully submitted,



Michael J. Bujold, Reg. No. 32,018

Customer No. 020210

Davis & Bujold, P.L.L.C.

112 Pleasant Street

Concord, NH 03301-2931

Telephone 603-226-7490

Facsimile 603-226-7499

E-mail: [patent@davisandbujold.com](mailto:patent@davisandbujold.com)

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- 2 -

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01/04/7

PATENT APPLICATION JAN 18 2007

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Volker BACHMANN, Mario STEINBORN,  
Serial no. : Rudolf KALTHOFF and Robert Anthony SAYMAN  
Filed : 10/563,417  
For : with an effective filing date of June 8, 2004  
METHOD FOR CONTROLLING AND  
REGULATING A TRANSMISSION BRAKE IN AN  
AUTOMATIC MOTOR VEHICLE  
TRANSMISSION

Group Art Unit :  
Examiner :  
Docket : ZAHFRI P803US

The Commissioner for Patents  
U.S. Patent & Trademark Office  
P. O. Box 1450  
Alexandria, VA 22313-1450

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## DECLARATION

I, Ludger Ronge of ZF Friedrichshafen AG, am the attorney most knowledgeable with the facts and circumstances concerning the following and hereby declare as follows:

ZF Friedrichshafen AG received a disclosure concerning the above identified application and a patent application was prepared from the same and filed in Germany on July 5, 2003 and given Patent Application No. 103 30 517.3.

This subject matter was also subsequently filed as PCT Application No. EP2004/006145 on June 8, 2004, claiming priority from German Patent Application No. 103 30 517.3.

Within the thirty (30) month term, my company, ZF Friedrichshafen AG, instructed our U.S. agent to complete the national stage formalities of PCT Application No. EP2004/006145 in the United States and, upon filing this application on January 4, 2006, our U.S. agent inquired as to whether the Assignee, ZF Friedrichshafen AG, had first obtained a foreign filing license for this subject matter in view of the U.S. inventor. As no foreign license was applied for or obtained before the corresponding German and the PCT applications were filed, the Assignee, ZF Friedrichshafen AG, is now seeking a Petition for Retroactive License under 37 C.F.R. § 5.25.

The subject matter for which the Petition for Retroactive License is being sought was not under a secrecy order, at the time it was filed abroad, and it is not currently under a secrecy order.

That upon discovery of the need for a foreign license, it is respectfully submitted that a foreign license is being diligently sought.

10/563,417

That as the undersigned representative of the Assignee, ZF Friedrichshafen AG, in charge of filing this subject matter, I did not appreciate that the naming of a U.S. inventor, with German inventors, necessitated the need to first obtain a foreign filing license from the United States Patent Office before filing this subject matter abroad, and it is respectfully submitted that such foreign filing of this subject matter abroad occurred, without first obtaining the required license under § 5.11, through error and without any deceptive intent.

The undersigned declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent(s) issuing thereon.

Date:

January 18, 2007

Ludger Ronge

*Ludger Ronge*

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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/563,417	22-Feb-06	VOLKER BACHMANN, ET AL.	ZAHFRI P803US

Title: METHOD FOR CONTROLLING AND REGULATING A  
TRANSMISSION BRAKE IN AN AUTOMATIC MOTOR  
VEHICLE TRANSMISSION

Correspondence Address:

MICHAEL J. BUJOLD  
500 N. COMMERCIAL ST., 4TH FL.  
MANCHESTER, NH 03101

Art Unit	Paper Number
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*mailed  
L&R  
12/5/06*

Please find attached a communication from the Examiner regarding the  
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

Michael J. Bujold  
500 North Commercial St., 4<sup>th</sup> Floor  
Manchester, MA 03101

In re: Wolker Bachmann, Et Al. : DECISION ON REQUEST  
Serial No.: 10/563,417 : UNDER 37 CFR 5.25  
Filing date: 22 February 2006  
Docket No: ZAHFRI P803U

Title: METHOD FOR CONTROLLING AND REGULATING A TRANSMISSION BRAKSE  
IN AN AUTOMATIC MOTOR VEHICLE TRANSMISSION

This is a decision on the petition filed on 22 February 2006 for a retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee ( § 1.17(h)).

The petition is **Denied** at this time per 37 CFR 5.25(a)3iii, the verified statement fails to provide a showing that the foreign filing license was diligently sought after discovery of the proscribed foreign filing. The U.S. application was filed 04 January 2005 according to the declaration signed by Ludger Ronge, but applicant did not file for a petition for a retroactive foreign filing license until over a year later 22 February 2006.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be

made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).

*Andrea M. Valenti*

Andrea M. Valenti  
Primary Examiner  
Group 3643  
(571)272-6895

14 November 2006

Practitioner's Docket No. ZAHFRI P803US**PATENT**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**NOTE (HAND CARRIED):** "Petitions for a foreign filing license pursuant to 37 CFR 5.12(b) for which expedited handling is requested and petitions for a retroactive license under 37 CFR 5.25, may be hand carried to the drop box located at the guard station in the Knox building. Upon approaching the guard station, the delivery personnel should state their desire to drop off the request. Correspondence packages will be inspected/scanned before being placed in the drop box. All requests should identify a fax number, telephone number and mailing address. All responses to the request will be sent by fax, followed by a mailed copy. If a fax number is not available, a hardcopy will be mailed to the mailing address provided." See "New Patents Central FAX Number and Updated Lists of Exceptions to the Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence", 1296 OG 76, July 12, 2005.

**NOTE (FACSIMILE):** "Petitions for a foreign filing license pursuant to 37 CFR 5.12(b), including a petition for a foreign filing license where there is no corresponding U.S. application (37 CFR 5.13): 571 273 0185 facsimile number." See "New Patents Central FAX Number and Updated Lists of Exceptions to the Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence", 1296 OG 76, July 12, 2005.

### PETITION FOR RETROACTIVE LICENSE (37 CFR 5.25)

**NOTE:** See M.P.E.P. § 140, 6th ed., rev. 3.

#### 1. Petition

It is respectfully requested that this petition for license for foreign filing attached hereto be granted retroactively under the provisions of 37 CFR 5.25.

#### 2. Previous Licenses ☐ applicable ☒ not applicable

Attached are copies of

- ☐ previous licenses  
☐ the filing receipt license

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***  
(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

#### MAILING

- ☒ deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 \*

- ☒ with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Addressee"

Mailing Label No. \_\_\_\_\_ (mandatory)

#### TRANSMISSION

- ☐ facsimile transmitted to the Patent and Trademark Office, (571) 273-0185.

Signature Michael J. Bujold

Michael J. Bujold

(type or print name of person certifying)

Date: 2/6/06

(Petition For Retroactive License (37 CFR 5.25) [22-5]—page 1 of 3)

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PROCESSING & REVIEW

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issued on this invention before the export.

**3. Material filed abroad without a license**

Attached is a copy of the material that was filed abroad without a license for foreign filing.

**4. Identification of Inventor(s), title of invention and, if applicable, details of corresponding U.S. application**

Inventor(s) name(s): Volker BACHMANN, Mario STEINBORN, Rudolf KALTHOFF and  
Robert Anthony SAYMAN  
Title of Invention: METHOD FOR CONTROLLING AND REGULATING A TRANSMISSION BRAKE  
IN AN AUTOMATIC MOTOR VEHICLE TRANSMISSION  
(complete the following, if applicable)

In re application of: Group No.:  
Application No.: 10/563,417 Examiner's Name:  
Filing Date: January 4, 2006

**5. Foreign Countries and dates of filing of material for which retroactive license requested (37 CFR 5.25(a)(1))**

With respect to the material for which a retroactive license is requested, each foreign country in which the patent application material was filed and the date it was filed is as follows:

<u>Foreign Country</u>	<u>Date</u>
Germany (DE103 30 517.3)	July 5, 2003
PCT (PCT/EP2004/006145)	June 8, 2004

**6. Verified Statement(s)**

Also attached hereto are the verified statement(s) of:

Ludger Ronge

which confirm(s) that, in accordance with 37 CFR 5.25(a)(3)(i)-(iii),

(Petition For Retroactive License (37 CFR 5.25) [22-5]—page 2 of 3)

- (a) the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order;
- (b) the license is being diligently sought after discovery of the proscribed foreign filing; and
- (c) an explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained.

NOTE: See 37 CFR 5.25(a)(4).

**7. Fee (37 CFR 1.17(g)—\$200.00)**

The fee for this petition for retroactive license is paid by

- ☒ Attached is a ☒ check ☐ money order in the amount of \$200.00
- ☐ Authorization is hereby made to charge the amount of \$ \_\_\_\_\_
- ☒ to Deposit Account No. 040213
- ☐ to Credit card as shown on the attached credit card information authorization form PTO-2038.

**WARNING:** Credit card information should not be included on this form as it may become public.

- ☒ Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

Reg. No.: 32,018

Tel. No.: (603 ) 624-9220

Customer No.: 020210

  
SIGNATURE OF PRACTITIONER

Michael J. Bujold

(type or print name of practitioner)

500 North Commercial Street, 4th Floor  
P.O. Address

Manchester, NH 03101



01/17/6

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Volker BACHMANN, Marlo STEINBORN,  
Serial no. : Rudolf KALTHOFF and Robert Anthony SAYMAN  
Filed : 10/563,417  
For : with an effective filing date of June 8, 2004  
METHOD FOR CONTROLLING AND  
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AUTOMATIC MOTOR VEHICLE  
TRANSMISSION  
Group Art Unit :  
Examiner :  
Docket : ZAHFRI P803US

The Commissioner for Patents  
U.S. Patent & Trademark Office  
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Alexandria, VA 22313-1450

DECLARATION

I, Ludger Ronge of ZF Friedrichshafen AG, am the attorney most knowledgeable with the facts and circumstances concerning the following and hereby declare as follows:

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Within the 30 month term, my company instructed our U.S. agent to complete the national stage formalities of the corresponding PCT application in the United States and, upon filing this application on January 4, 2005, our U.S. agent inquired as to whether ZF Friedrichshafen AG had first obtained a foreign filing license for this subject matter in view the U.S. inventor. As no foreign license was applied for or obtained before the corresponding German and PCT applications were filed, ZF Friedrichshafen AG is now filing a Petition for Retroactive License under 37 C.F.R. § 5.25.

The subject matter for which the Petition for Retroactive License is being sought was not under a secrecy order, at the time it was filed abroad, and it is not currently under a secrecy order.

That upon discovery of the need for a foreign license, a foreign license is being diligently sought.

As the undersigned representative of ZF Friedrichshafen AG in charge of filing this subject matter, I did not appreciate that the naming of a U.S. inventor, with German inventors,

10/563,417

necessitated the need to first obtain a foreign filing license from the United States Patent Office before filing this subject matter abroad, it is respectfully submitted that such foreign filing of this subject matter abroad occurred, without first obtaining the required license under § 5.11, through error and without deceptive intent.

The undersigned declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent(s) issuing thereon.

Date:

January 25, 2006

Ludger Ronge